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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

WAYMO LLC,

Plaintiff,

vs.

UBER TECHNOLOGIES, INC.;
OTTOMOTTO LLC; OTTO TRUCKING
LLC,

Defendants.

CASE NO. 3:17-cv-00939

**Patent Local Rule 4-3 Joint Claim
Construction and Prehearing Statement**

Pursuant to Patent Local Rule 4-3, Plaintiff Waymo LLC (“Waymo”) and Defendants Uber Technologies, Inc. (“Uber”), OttoMotto LLC (“OttoMotto”), and Otto Trucking LLC (“Otto Trucking”) (collectively, “Defendants”) hereby submit this Joint Claim Construction and Prehearing Statement regarding claim construction for U.S. Patent No. 9,368,936 (the “’936 Patent”).

Patent Local Rule 4-3(a): Agreed Construction

At this time, the parties have not reached agreement on the construction of any terms in the ’936 Patent. However, the parties will continue to meet and confer in good faith in an effort to narrow the issues in dispute.

Patent Local Rule 4-3(b): Proposed Constructions

Exhibit A sets forth each party’s proposed construction of each disputed term, together with an identification of all references from the specification or prosecution history that support that construction, and an identification of any extrinsic evidence known to the party on which it intends to rely either to support its proposed construction or to oppose any other party’s proposed construction, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses.¹

Patent Local Rule 4-3(c): Most Significant Terms

The parties are currently disputing three claim terms from the ’936 Patent: “diode,” which appears in asserted independent claims 1, 9, and 17; “charging path,” which appears in asserted independent claims 1, 9, and 17; and “wherein the capacitor is charged immediately following emission of a pulse of light from the light emitting element” in asserted dependent claims 3, 11, and 19.

Waymo’s Position: Waymo does not believe that the “diode” and “charging path” terms are case or claim dispositive. Under either party’s proposed construction for these terms, a dispute will remain concerning infringement of the asserted claims. Waymo considers the “immediately” term to

¹ The parties’ have agreed to a claim construction briefing schedule that provides for the exchange of expert reports in connection with the parties’ respective briefs.

1 be claim dispositive for the asserted dependent claims in which the term appears because Defendants
 2 have alleged that the term renders those claims indefinite.

3 **Defendants' Position:** There are only three disputed claim terms for the '936 Patent and all
 4 are significant to the resolution of this case and are case or claim dispositive. The term "diode" is
 5 dispositive because Defendants' construction undermines Waymo's infringement argument under the
 6 doctrine of equivalents. The term "charging path" is dispositive because it is relevant to non-
 7 infringement. And the term "immediately" is dispositive for the dependent claims in which the term
 8 appears because under Defendants' construction, the term is indefinite.

9 **Patent Local Rule 4-3(d): Anticipated Length of Time for a Hearing**

10 The parties understand that the Court does not anticipate holding a claim construction hearing
 11 in this case, but instead will resolve claim construction disputes in connection with dispositive
 12 motions.

13 **Patent Local Rule 4-3(e): Identification of Hearing Witnesses**

14 To the extent the Court holds a hearing on dispositive motions that addresses claim
 15 construction, the parties may call the following witnesses to testify:

16 **Waymo:** Waymo may call Dr. Andrew Wolfe, Ph.D., to testify concerning the knowledge of
 17 a person of ordinary skill in the art at the time of the invention and the meaning that each of the
 18 disputed claims terms would have to a person of ordinary skill in the art when read in the context of
 19 the intrinsic record. Dr. Wolfe may also provide testimony concerning Defendants' indefiniteness
 20 argument with respect to the phrase "wherein the capacitor is charged immediately following emission
 21 of a pulse of light from the light emitting element" in asserted dependent claims 3, 11, and 19 of the
 22 '936 Patent. In particular, Dr. Wolfe may provide opinions to show that a person of ordinary skill in
 23 the art would have reasonable certainty concerning the scope and meaning of this phrase when read in
 24 the context of the intrinsic record.

25 **Defendants:** Defendants expect to provide expert testimony from Dr. Philip Hobbs
 26 regarding: (1) the state of the art of the '936 Patent; (2) the level of a person of ordinary skill in the art
 27 at the time of the '936 Patent; (3) disclosed embodiments in the '936 Patent; (4) how a person of
 28 ordinary skill would interpret the claim language in view of the intrinsic record of the '936 Patent; and

1 (5) opinions offered by any expert retained by Waymo. Alternatively or in addition to, Defendants
2 may provide expert testimony on one or more of the above topics from Dr. Michael Lebby.

3 **Patent Local Rule 4-3(f): Identification of Factual Findings**

4 **Waymo's Position:** Waymo requests that the Court make factual findings with respect to
5 Defendants' indefiniteness argument for the phrase "wherein the capacitor is charged immediately
6 following emission of a pulse of light from the light emitting element" in claims 3, 11, and 19 of the
7 '936 Patent. These factual findings will relate to the knowledge and understanding that a person of
8 ordinary skill in the art would have concerning the scope and meaning of the phrase when read in the
9 context of the intrinsic record. Waymo does not believe any other factual findings are necessary
10 related to claim construction, however, to the extent the Court is inclined to make additional factual
11 findings regarding the two other disputed claim terms, Waymo requests that the Court find that the
12 evidence cited by Waymo and Defendants supports Waymo's claim construction proposals for
13 "diode" and "charging path" and do not support Defendants' proposals.

14 **Defendants' Position:** Defendants request that the Court make factual findings that the
15 extrinsic evidence cited by Defendants support both their constructions of "diode" and "charging
16 path" and their position that the term "wherein the capacitor is charged immediately following
17 emission of a pulse of light from the light emitting element" is indefinite.

1 DATED: August 2, 2017

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ATTESTATION

In accordance with Civil Local Rule 5-1(i)(3), I attest that concurrence in the filing of this document has been obtained from any other signatory to this document.

By: /s/ Charles K. Verhoeven
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